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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,885	10/17/2001	Robert E. Haines	10013718-1	7082

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/981,885	Applicant(s) HAINES, ROBERT E.	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,32-34,38,39 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,32-34,38,39 and 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The cancellation of claims 2, 6-31, 35-37, and 40 are acknowledged.
2. In view of the appeal brief filed on 05-18-06, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

3. The finality of the Office action mailed is hereby withdrawn in view of the new ground of rejection set forth below.
4. The 112 rejections are withdrawn due to Applicant's arguments.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, and 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,090,027 to Brinkman.

Brinkman teaches a sheet of print media (Brinkman, Fig. 14A-14C, 16A-16C and associated text), the sheet comprising: face; edge; a fluid-based marking positioned on a the face and/or from the edge, the edge covering an area that is adjacently positioned and substantially perpendicular to an area of the face; and wherein the fluid-based marking comprises data for configuring an imaging device for printing on the sheet from the face and/or from the edge (Brinkman, Abstract and col. 21, lines 10-20).

Regarding claim 2, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is positioned on the face and on an adjacent and substantially perpendicular edge; and wherein the fluid-based marking comprises data for configuring operations of the imaging device for printing on the sheet (Brinkman, Fig. 14A-14C, 16A-16C and associated text).

Regarding claim 3, Brinkman teaches a sheet as recited in claim 1, wherein the fluid-based marking is imprinted on the edge and not imprinted on the face, (Brinkman, col. 8, lines 37-40, the ink may or may not be on the sheet).

Regarding claim 4, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is ink (Brinkman, Abstract and col. 21, lines 10-20).

Further regarding claim 1, Brinkman teaches a sheet as recited in claim 1, wherein the data is for configuring the image device to form images on the sheet for printing on the sheet (Brinkman, Fig. 14A-14C, 16A-16C and associated text), as ink is on the sheet. Further, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to

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be employed does not differentiate the claimed invention from a prior art invention satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Instant claims 1, 3-4, and 41-43 are met.

Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,127,677 to Merry.

Merry teaches a stack of print media sheets, each sheet in the stack being skewed at an angle with respect to the next sheet in the stack such that a portion of a face of each sheet is exposed, (FIG. 1, e.g. see plurality of sheets) and a fluid-based marking on the exposed face of each sheet and on an adjoining edge of each sheet, the marking continuous from the face of each sheet to the edge of each sheet (18, FIG. 1 and associated text, 20, FIG. 2 and associated text, markings 20 of FIG. 2 are made by means of machines such as inkjet or laser printing. That the marking is machine readable data for configuring an imaging device for printing on the sheets in the stack is a functional equivalent as the same ink marking is used and would function as machine readable in view of absence of a definition in the specification, the term "machine readable" is given its broadest reasonable interpretation. Further because the ink is carried out by an ink jet printer or laser printer, such a printer performs complex calculations that must be inherently operated by software located on a computer readable device and operated by a computer with a memory for storing instructions.

Claims 1 3-4, and 41-43 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,598,783 to Brinkman.

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Brinkman teaches a sheet of print media (Brinkman, Fig. 1A-1B, 5B-5C, 6C, 7B, 7F-7I, and 11-12 and associated text), the sheet comprising the sheet comprising: face; edge; a fluid-based marking positioned on a the face and/or from the edge, the edge covering an area that is adjacently positioned and substantially perpendicular to an area of the face; and wherein the fluid-based marking comprises data for configuring an imaging device for printing on the sheet from the face and/or from the edge (Brinkman, Abstract and col. 2, lines 22-35).

Regarding claim 2, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is positioned on the face and on an adjacent and substantially perpendicular edge; and wherein the fluid-based marking comprises data for configuring operations of the imaging device for printing on the sheet (Brinkman, Fig. 1A-1B, 5B-5C, 6C, 7B, 7F-7I, and 11-12 and associated text).

Regarding claim 3, Brinkman teaches a sheet as recited in claim 1, wherein the fluid-based marking is imprinted on the edge and not imprinted on the face, (Brinkman, 41, Fig. 6B and associated text).

Regarding claim 4, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is ink (Brinkman, Abstract and col. 2, lines 22-35).

Further regarding claim 1, Brinkman teaches a sheet as recited in claim 1, wherein the data is for configuring the image device to form images on the sheet for printing on the sheet (Brinkman, Fig. 14A-14C, 16A-16C and associated text), as ink is on the sheet. Further, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed invention from a prior art invention satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 32, 34, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,598,783 to Brinkman.

Brinkman essentially teaches the claimed invention relied upon above.

To claim 32, Brinkman teaches fluid marking continuous from the face to the edge representing machine readable data (IFE 31, FIG. 7C and associated text, e.g. marking of ink imprinted for scanning (a scanner is a machine that reads data). See also col. 6, lines 20-55.

Brinkman does not teach claims 5, 32, and 38 to a plurality and/or adjoining faces and/or edges or to a stack of print media comprising a plurality of sheets, each sheet being a sheet as recited in claim 1.

Unless the reference teaches away from duplicating said sheet, it is obvious to provide a plurality of faces, edge adjoining faces and sheets as claim 1 or 32 motivated by the desire of providing multiple markings for identification. Additionally, the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. Further a plurality of faces is taught as Brinkman shows a top and bottom face and plurality of edges adjoining each top and bottom face (Fig. 7s, col. 5, line 1).

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To claim 34, because the prior art does not expressly disclose a sheet having sufficient capillary action properties to carry the fluid-based marking, the Examiner interprets that the sheet of the prior art does not have sufficient capillary action.

Claims 5, 32-34, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,090,027 to Brinkman.

Brinkman essentially teaches the claimed invention relied upon above.

Brinkman does not teach claims 5, 32, and 38 to a plurality and/or adjoining faces and/or edges or to a stack of print media comprising a plurality of sheets, each sheet being a sheet as recited in claim 1.

Unless the reference teaches away from duplicating said sheet, it is obvious to provide a plurality of facial portions, edge portions and sheets as claim 1 or 32 motivated by the desire of providing multiple markings for identification at more than one location. Additionally, the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. Further a plurality of faces is taught as Brinkman shows a top and bottom face and plurality of edges adjoining each top and bottom face (See all Figures).

To Claim 33, Brinkman teaches the fluid-based marking is a barcode (col. 21, lines 16-35).

To claim 34, because the prior art does not expressly disclose a sheet having sufficient capillary action properties to carry the fluid-based marking, the Examiner interprets that the sheet of the prior art does not have sufficient capillary action.

Response to Arguments

Applicant's arguments have been considered but are not persuasive.

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Applicant argues Brinkman '027 or '783 does not teach the instant invention as per claim 39 recites. Applicant argues that the type of information is for pricing an item, not for machine readable data. However, while Brinkman '027 and '783 teach ink information for pricing, Applicant also teaches the ink is scanned and readable by laser or scan which indicates a machine is used. Further both Brinkman disclose the use of imprinted bar codes and bar codes are read by a machine (Brinkman '783 —col. 4, lines 35-41; Brinkman '027-col. 21, lines 16-35).

Applicant argues that both Brinkmans teach marking imprinted on a label, a box, or envelope and being folded, but not a sheet. A label, box, or envelope is indeed a sheet. "A sheet" is broad enough to encompass any type of sheet. Applicant has not amended the claims to exclude folds or specify what type of sheet is intended but is welcomed to do so.

Applicant argues neither Brinkman teaches each sheet in the stack being skewed at an angle to expose sheets. Now, Merry is used to teach this limitation.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicús
Examiner
Art Unit 1774

May 18, 2006



RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774

5/19/06